

**REMARKS**

Claims 36-39, 44-47 and 53-56 are pending. By this Amendment, claims 45 and 46 are amended to even more clearly distinguish over the applied reference. No new matter is added. Although page 8 of the Office Action states that the Office Action is a Final Rejection, the PTO database and the PTOL-326 accompanying the Office Action correctly state that the Office Action (which was issued after the submission of an RCE) is non-final.

**I. Information Disclosure Statement**

The Examiner is requested to consider the information submitted with the attached Information Disclosure Statement. This Information Disclosure Statement re-submits the information that was originally submitted with an April 6, 2001 Information Disclosure Statement. Each foreign patent reference is clear and all but one includes a translation. The foreign patent references are discussed in the specification. The two foreign non-patent publications are discussed in the Appendix filed with this Information Disclosure Statement. Return of an initialed PTO-1449 is requested.

**II. Amendment of Inventorship**

Applicants filed an Amendment of Inventorship on September 20, 2006 in which the inventorship was amended due to cancellation of the withdrawn, non-elected claims. The Examiner is requested to confirm that the Amendment to Inventorship has been entered.

**III. All Pending Claims are Patentable**

Claims 45, 46, 54 and 56 stand rejected under 35 U.S.C. §102(e) over U.S. Patent No. 6,266,483 (Okada et al.). This rejection is respectfully traversed.

Contrary to what is asserted in the Office Action, Okada et al. does not disclose or suggest the combinations of features recited in independent claims 45 and 46. Regarding claim 45, Okada et al. does not disclose or suggest the claimed plurality of manual operation members in which one of those manual operation members (a same one of the plurality of

manual operation members) is used to start playback of the still image as still image format and the playback of the visual broadcast program. Regarding claim 46, Okada et al. does not disclose or suggest the claimed plurality of manual operation members in which one of those manual operation members (a same one of the plurality of manual operation members) is used to start recording of the still image as still image format and the recording of the visual broadcast program. The Office Action refers to Okada et al. Fig. 7 and asserts that "on the front panel DVD recorder are manual operation controllers for providing user interface to system controller." The Office Action further asserts that "recording and playing back the various types of data are thus started by operation of the same one of plurality of manual operation members." The Examiner is requested to explain the basis for the conclusion that a single one out of a plurality of manual operation members in the Okada et al. DVD recorder starts playback or starts recording of the still image as still image format and of the visual broadcast program. Fig. 7 of Okada et al. does not show one manual operation member that is used to start recording of still image and visual broadcast program or one manual operation member that is used to start playback of still image and visual broadcast program. The written specification of Okada et al. also does not disclose such a feature. Okada et al. generally mentions a user interface at col. 16, lines 1-6 and col. 16, lines 22-25. However, the features of claims 45 and 46 discussed above are not described in Okada et al.

Accordingly, Okada et al. does not disclose all features of independent claims 45 and 46. Withdrawal of the rejection is requested.

Claims 47, 53 and 55 stand rejected under 35 U.S.C. §103(a) over Okada et al. This rejection is respectfully traversed. These claims are patentable for at least the reasons set forth above with respect to their corresponding independent claims 45 and 46. Withdrawal of the rejection is requested.

Claims 36-38 and 44 stand rejected under 35 U.S.C. §103(a) over Okada et al. in view of JP-A-10-129082 (Fumio). This rejection is respectfully traversed.

Regarding independent claims 36 and 44, the Office Action acknowledges that Okada et al. fails to disclose interrupting the recording (claim 36) or playback (claim 44) of the digital image data when recording instructions (claim 36) or playback instructions (claim 44) of the visual broadcast program are detected during the recording (claim 36) or playback (claim 44) of the digital image data. The Office Action, however (1) takes "official notice that it was well known at the time of the invention to assign priorities for recording select broadcast programs... wherein the priority is used to determine the importance of programs for conflict resolution" and (2) asserts that the Abstract and paragraph [0006] of Fumio "teaches the step of detecting a higher priority record condition when presently recording a lower priority data, and interruption of the recording of the lower priority data to record the higher priority data and resuming the lower priority recording upon completion of the higher priority recording." The Office Action then asserts that it would have been obvious to modify the system of Okada et al. "by assigning priorities to select broadcast programs, and interrupting the recordation of still image data in order to record the higher priority broadcast programs, thereby enabling image recorder to record programs that are highly preferred by the viewer."

First, the Office Action fails to address the claim 44 features which relate to playback, not recording. Thus, the Office Action has failed to establish a *prima facie* case of obviousness with respect to claim 44.

Furthermore, the Examiner is requested to provide documentary support of its allegation regarding official notice.

Finally, Applicant respectfully submits that it would not have been obvious to modify the Okada et al. system in view of the alleged "official notice" and in view of Fumio so as to

result in the combinations of features recited in independent claims 36 and 44. In particular, as is clear from the Abstract and paragraphs [0028]-[0031] of Fumio, Fumio relates to printing, not recording of data in a storage or playback of data from a storage. Fumio ensures that sufficient paper exists for a higher priority print job by printing that higher priority print job if sufficient paper would not be present to print that job and other lower priority jobs. Accordingly, Fumio does not suggest modifying the system of Okada et al. in the manner proposed in the Office Action. Withdrawal of the rejection is requested.

Claim 39 stands rejected under 35 U.S.C. §103(a) over Okada et al. in view of Fumio, and further in view of WO 92/22983 (Browne). This rejection is respectfully traversed. Browne does not overcome the deficiencies noted above with respect to the rejection of claim 36, from which claim 39 depends. Accordingly, claim 39 also is patentable. Withdrawal of the rejection is requested.

#### **IV. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number set forth below.

Respectfully submitted,



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MAC/ccs

Attachments:

Petition for Extension of Time  
Information Disclosure Statement

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